

**REMARKS****Claim Rejections - 35 U.S.C. § 112**

Claims 1 and 11 were rejected under 35 U.S.C. § 112 first paragraph, as failing to comply with the written description requirement. Specifically, the examiner asserts that the phrase “restraining the customer’s ability to add software or hardware” is not disclosed in the specification in a way that meets the written description requirement. It is respectfully submitted that claims 1 and 11 comply with the written description requirement.

It is a well settled issue in patent law that the disclosure as originally filed does not have to provide *in haec verba* support for the claimed subject matter. *See Crown Operations Int’l, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1376, 62 U.S.P.Q. 2d 1917 (Fed. Cir. 2002). *See also* MPEP § 2163 (I)(B). Based on the rejection, it appears as if the examiner is requiring *in haec verba* support for the phrase in question.

In particular, the examiner asserts that the specification does not specifically disclose that controlling a user’s ability to add hardware or software includes restraining a customer’s ability to add software or hardware. As there is no requirement for the term restrain to be present in the specification the rejection is respectfully traversed.

Also, the ordinary meaning of term control, and the way in which control is used in the specification, both support the conclusion that control includes restraint. For example, in some embodiments of the present invention a person using a client 12 may select a HELP button 38. In doing so, an interface 50 may be generated that the user may use to report a problem to a service provider. The service provider may diagnose the reported problem. Specification page 10, lines 17-26. In an ideal situation, the service provider may remotely manage the client to overcome the problem. In fact, in some embodiments of the present invention, the service provider maintains client systems in working order. Specification page 11, lines 1-9. Part of the service provider’s responsibilities in maintaining a client in working order may be to control the user’s

ability to add additional hardware or software to the client system. *Id.* Controlling the user's ability to add hardware or software ensures that the client system runs as intended and reduces the possibility of unexpected hardware or software problems. *Id.* Thus, if a user were to try to add software or hardware that would lead to problems, the service provider could control the addition of the hardware or software. Because the specification clearly demonstrates that control may include limiting or preventing a user from doing certain things (*See, e.g.*, page 5, lines 16-26; page 10, lines 8-16), it is respectfully submitted that the specification and the ordinary meaning of the term control also disclose restraining as used in claims 1 and 11. As such, claims 1 and 11 are believed to comply with the written description requirement of § 112, paragraph 1.

In the body of the § 112 rejection, the examiner refers to claim 21. Apparently, claim 21 was not rejected under § 112. But, if claim 21 was rejected, the rejection is believed to be improper. Nevertheless, the examiner argues that controlling means controlling what a customer *can add* or what a customer *cannot add*. Thus, per this argument it is submitted that controlling includes limiting or preventing. As such, reconsideration of the rejection is requested.

#### **Claim Rejections – 35 U.S.C. § 103(a)**

Claims 1, 11, and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Netsurfer as taught by "Netsurfer makes it easy" Broadwatch Magazine; Todd Judd Erickson January 2000, in view of "ZipLink's Virtual Internet Service Provider (ISP) Program Provides complete Turnkey Outsourcing Option PR" Newswire; New York; November 4, 1999.

With respect to claim 21, Netsurfer is relied on as teaching controlling the ability of the customer to add software or hardware. However, claim 21 calls for *preventing* the customer from adding software or hardware to the system. Claim 21 was apparently not rejected under § 112, paragraph 1. Thus, it is respectfully submitted that Netsurfer fails to disclose preventing a customer from adding software or hardware to a system. In particular, Netsurfer merely pushes content to a user's computer. *See Microsoft Press*

*Computer Dictionary*, 390 (3d ed. 1997), attached. Pushing a program fails to teach or disclose *preventing* the consumer from adding software or hardware. Thus, Netsurfer fails to disclose preventing a customer from adding software or hardware to the customer's system.

The examiner also argues that Ziplink inherently prevents (not allowing) the customer from adding software. To be inherent, the evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference. See *In re Robertson*, 169 F.3d 743, 745, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999). Mere probabilities or probabilities that may result from a given set of circumstances is insufficient to establish inherency. *Id.*

The examiner has not established that Ziplink inherently discloses the missing descriptive matter. For example, while Ziplink may provide a complete ISP outsourcing option with customer care management services such as customer sign-up, activation, and authentication, and 24 hour a day, 7 day a week customer support, it is respectfully submitted that Ziplink's customers do not necessarily have to provide an option that could prevent some of their customers from accessing inappropriate web sites. In other words, it might be desirable to provide an option that prevents a user from accessing an inappropriate web site, such as through parental control; such an option is not necessarily present in Ziplink. That is, the mere possibility that an unlisted service might be provided fails to establish that the given service must necessarily be provided. As such, *prima facie* obviousness has not been established with respect to independent claim 21 or claims dependent thereon.

Under a similar analysis, *prima facie* obviousness has not been established for independent claims 1 or 11, or claims dependent thereon.

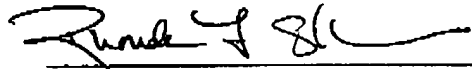
**CONCLUSION**

In view of the remarks herein, the application is in condition for allowance. The examiner's prompt action in accordance therewith is respectfully requested.

The commissioner is authorized to charge any additional fees, including extension of time fees, or credit any overpayment to the Deposit Account Number 20-1504 (ITL.0391US).

Respectfully submitted,

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Rhonda L. Sheldon, Reg. No. 50,457  
TROP, PRUNER & HU, P.C.  
8554 Katy Freeway, Suite 100  
Houston, TX 77024  
713/468-8880 [Phone]  
713/468-8883 [Fax]

Attorneys for Intel Corporation

Customer No.: 21906